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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/273,238      | 03/19/1999  | JAMES GOODWIN        | 003829.P003         | 6862             |

7590

11/20/2002

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EXAMINER

JUNG, MIN

ART UNIT

PAPER NUMBER

2663

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/273,238

Applicant(s)

GOODWIN ET AL.

Examiner

Min Jung

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 1999.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1-16 recite "split transaction". This feature is not clearly described in the specification. Specification pages 59-64 contain explanation of operation involving "split transaction". However, it is not described anywhere what these 'split transactions' are. Is it implying that a transaction is some kind of unit of communication session, and that the session is split into more than one separate session?

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 4 and 5, "a bus device" and "the device", respectively, lack clear antecedent basis; are they both referring to the "a device coupled to a bus over a network" recited in preamble?

In claim 11, lines 4-7, the clause is tangled, and therefore, is unclear in meaning; if the sequence of the functions are important, it should be clearly recited to reflect such aspect.

Claims 13 and 15 have the similar kind of indefiniteness as claim 11 addressed above.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 11-17, 19, 21-23, 26-29, 31-32, 34-36, 39-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Xu et al., 6,151,628 (Xu).

Xu discloses a method for connecting a source of digital data to a computer network in which a tunneling call acceptance procedure is taught. See Fig. 6. Xu specifically teaches a write request (incoming call 100 and the access request 102), acknowledge complete (call accept), encapsulating the write request into packets with tunneling header (incoming call request with dialing number of the remote user, the telephone number dialed, and a subaddress 106), transmitting the packets over the network (IP packet transfer 128), and receiving a response that write request data has been delivered to a network host (access reply 104). See col. 11, line 20 – col. 12, line 11.

Further, note that the terms such as “immediately beginning ----”, or “sends---- as soon as----” have not been given much weight in interpreting the claims since such expressions of timing are relative, and does not specifically limit the claims.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18, 20, 24-25, 30, 33, 37, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu in view of Gerszberg et al., 6,480,748 (Gerszberg).

Xu fails to specifically teach IEEE 1394 devices. Gerszberg teaches IEEE 1394 bus and devices used in conjunction with tunneling scheme used in access network.

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See Figs. 2, 5, 9, 14 and 15. It would have been obvious for one of ordinary skill in the art at the time of the invention to implement the teaching of Xu by adopting the IEEE 1394 devices as taught by Gerszberg since it was known to use IEEE device and bus for connecting to a network using tunneling scheme.

9. Claims 6, 7, 9, 10, 42, 43, 45-49, 51-60, 62-72, 74-75, 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chau et al., 6,233,232 (Chau).

Chau discloses architecture for connecting a plurality of telephone lines to a computer network. Specifically, Chau teaches a network (130), a bus (140, 142, 144), a bus device coupled to the bus (computer system 150, 152, 154), an interface (network access server 100, 110, 120) coupling the network to the bus, the interface tunneling bus events over the network to and from the bus device by encapsulating bus events generated by the bus device into packets and transferring the encapsulated bus events over the network for subsequent decapsulation to recreate the bus events. See col. 6, line 48-54, and col. 7, lines 47-49.

Chau fails to specifically teach sending an announcement packet over the network that encapsulates bus event corresponding to a bus reconfiguration process for the bus. However, Chau teaches establishing multilink connections through multiple network access servers. This process involves receiving request for multilink connection and allocating logical and physical ports for connections establishment. See Fig. 13 and col. 13, lines 16-34. This process is a configuration in logical sense. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to

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implement the connection establishment of Chau by sending bus configuration command.

Chau further fails to teach a Universal Serial Bus (USB) device coupled to the bus. USB device is well known in the field of the invention as recognized by applicant in the present specification page 3. It refers to a device conforming to the Universal Serial Bus Standard. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to implement Chau's system by specifically utilizing USB device as the bus device.

10. Claims 8, 44, 50, 61, 73, 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chau in view of Gerszberg.

Chau fails to specifically teach IEEE 1394 bus. Gerszberg teaches IEEE 1394 bus and devices used in conjunction with tunneling scheme used in access network. See Figs. 2, 5, 9, 14 and 15. It would have been obvious for one of ordinary skill in the art at the time of the invention to implement the teaching of Chau by adopting IEEE 1394 devices of Gerszberg since it is well known in Gerszberg to utilize IEEE 1394 devices in tunneling scheme.

#### ***Allowable Subject Matter***

11. The following is a statement of reasons for the indication of allowable subject matter: Prior art fails to teach or fairly suggest method comprising: capturing the one or more bus events corresponding to a split transaction (?) generated by a bus device and sending an indication or response to the device that the transaction has been completed

using a network interface; encapsulating the captured bus events into packets associated with a network protocols using the network interface after sending the indication or response; and sending the packets over the network to a remote site, where the one or more bus events encapsulated in the packets are decapsulated in order to recreate the one or more bus events.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Araujo et al. Patent, 6,301,229, the Chau et al. Patent, 6,147,987, the Chau Patent, 6,026,085, the Steinka et al. Patent, 6,285,680, the Batz et al. Patent, 5,918,022, the Araujo et al patent, 6,118,785, and the Comstock patent, 6,452,920 are cited for further references.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 703-305-4363. The examiner can normally be reached on Monday-Friday, 7AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-308-5340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

MJ  
November 15, 2002

A handwritten signature in black ink, appearing to read "Min Jung", written in a cursive style.

Min Jung  
Primary Examiner